

# Exhibit 1

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14 Attorneys for Plaintiff Creative Integrated Systems, Inc.

**UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA, SOUTHERN DIVISION**

18 CCREATIVE INTEGRATED  
19 SYSTEMS, INC.,

20 Plaintiff,

21 | v.

22 NINTENDO OF AMERICA, INC.;  
23 NINTENDO CO., LTD.; MACRONIX  
24 AMERICA, INC.; and MACRONIX  
INTERNATIONAL CO., LTD.; and  
DOES 1-10 Inclusive.

25 Defendants.

**CASE NO. CV10-2735 AHM (VBKx)**

## **JURY TRIAL DEMANDED**

**PLAINTIFF'S RESPONSES TO  
DEFENDANT NINTENDO CO.,  
LTD'S FIRST SET OF  
INTERROGATORIES PURSUANT  
TO FED. R. CIV. P. (RELEVANT TO  
THE DEFENSES OF LACHES,  
ESTOPPEL, and NOTICE UNDER 35  
U.S.C. § 287)**

1

2 Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure, Plaintiff  
3 Creative Integrated Systems, Inc. (“Creative,” “CIS”, or “Plaintiff”) hereby serves  
4 its objections and responses to Defendant Nintendo Co. Ltd.’s First Set of  
5 Interrogatories.

6

### **GENERAL OBJECTIONS**

7 Creative incorporates each of the following General Objections into its  
8 Responses to Defendant’s Requests:

9 A. Creative objects to each Interrogatory to the extent that it calls for  
10 documents or information protected from discovery by the attorney-client privilege,  
11 the litigation work-product doctrine, any other common law or statutory privilege,  
12 and/or any extension of any of the foregoing privileges or protections (e.g., the joint  
13 defense privilege and/or common interest doctrine). Such documents or  
14 information shall not be produced intentionally in response to the Requests, and any  
15 inadvertent production shall not be deemed a waiver of any privilege or protection  
16 with respect to such documents or information.

17 B. Creative objects to each Interrogatory to the extent that it does not  
18 concern Defendants’ defenses of laches, estoppel, or notice under 35 U.S.C. §  
19 287(a), or to the extent that it exceeds the scope of Court-ordered discovery in this  
20 action.

21 C. By stating that documents or information will be produced in response  
22 to a Interrogatory, Creative does not represent that such documents or information  
23 exist; are within Creative’s possession, custody or control; or are otherwise  
24 available to Creative. Rather, Creative merely states that if such documents or  
25 information exist, are within Creative’s possession, custody or control, are not  
26 subject to objection, and can be located in a reasonable search of the likely  
27 repositories of documents or information, such documents or information shall be  
28 produced to the extent consistent with Creative’s responses and objections.

1           D. Creative's responses and associated productions are made to the best of  
2 its present knowledge, information, and belief based upon information and  
3 documents currently available to Creative and a reasonable search for responsive  
4 documents and information. Creative's responses and document productions are  
5 subject to modification and/or supplementation as further investigation may  
6 warrant. Creative reserves the right to continue discovery and investigation into  
7 this matter and to present additional information discovered after the date of this  
8 response at trial or otherwise.

9           E. By this response Creative preserves, and does not waive, any objections  
10 or other challenges as to the competency, relevance, materiality or admissibility of  
11 evidence of any document or information identified or produced herein, whether in  
12 this or any other action.

13           F. Creative objects to any instruction, definition, or Request as overly  
14 broad and unduly burdensome to the extent that it calls for discovery of documents  
15 or information that are not relevant to the claims, defenses or subject matter of this  
16 litigation, not reasonably calculated to lead to the discovery of admissible evidence,  
17 or unlimited in scope or time.

18           G. Creative objects to any instruction, definition, or Interrogatory to the  
19 extent that it purports to impose obligations upon Creative greater than or different  
20 than those contained in the Federal or Local Rules or any other applicable law. For  
21 example, Instructions D, G and H purport to impose obligations greater than those  
22 imposed by the Federal Rules of Civil Procedure and/or the Local Rules of this  
23 District. Creative assumes no burdens greater than those imposed by these rules  
24 and laws in responding to these Interrogatories.

25           H. Creative objects to each Interrogatory to the extent that it utilizes words  
26 or phrases that (i) assume facts not established; (ii) constitute, form, imply, require  
27 or call for a legal conclusion; or (iii) incorporate characterizations or opinions.  
28 Creative further objects to each Interrogatory to the extent that it contains

1 incomplete, inaccurate or misleading descriptions or characterizations of facts,  
2 events and pleadings in this action. By providing these responses, Creative  
3 undertakes no obligation to search for or produce documents that may be  
4 responsive under a correct or complete view of the facts; Creative will respond to  
5 the Interrogatories as served by Defendant, even if such Interrogatories are  
6 erroneous or incomplete.

7 I. Creative objects to each Interrogatory to the extent the documents  
8 requested are in the public domain. Creative undertakes no obligation to search for  
9 or produce documents that are in the public domain and equally available to  
10 Defendant.

11

## 12 RESPONSES TO INTERROGATORIES

13 **Interrogatory No. 1.** Identify each claim of the Patents-In-Suit that CIS  
14 contends was infringed by any defendant and for each of such asserted claim,  
15 identify which claim is alleged to be infringed by which accused product.

16 **Response:** CIS objects to this Interrogatory on the grounds that it seeks  
17 information neither relevant to nor reasonably calculated to lead to the discovery of  
18 admissible evidence relating to Defendants' affirmative defenses of laches, estoppel,  
19 and notice under 35 U.S.C. § 287. The Court permitted limited discovery on these  
20 affirmative defenses, for which Defendants bear the burden of proof. The question  
21 of "each claim of the Patents-in-Suit that CIS contends was infringed by any  
22 defendant" is not relevant to, and not reasonably calculated to lead to the discovery  
23 of admissible evidence on, the affirmative defenses of laches, estoppel, and notice  
24 under 35 U.S.C. § 287.

25 CIS also objects to this Interrogatory on the ground that it is premature under  
26 the Court's current case management and discovery schedule and, therefore, is  
27 overly broad and unduly burdensome. This Interrogatory seeks information  
28 regarding CIS's infringement contentions – namely, "each claim of the Patents-in-

1 Suit that CIS contends was infringed by any defendant" and by which accused  
2 product. Defendants have produced no documents and otherwise provided no  
3 discovery as to their products, including the products identified in the Second  
4 Amended Complaint alleged to infringe. Moreover, there is no case management  
5 schedule yet in place that requires CIS to provide its infringement contentions.  
6 Indeed, Defendants objected to any contention-based discovery relating to  
7 infringement, validity, enforceability, or damages, and instead proposed a limited,  
8 phased discovery period focused solely on Defendants' affirmative defenses that,  
9 according to Defendants, may (if successful) limit CIS's damages in this case. The  
10 Court, at Defendants' urging, adopted such a limited discovery plan. Accordingly,  
11 Defendants' attempt to obtain discovery directed to CIS's infringement contentions  
12 is premature.

13

14 **Interrogatory No. 2.**

15 State in detail all facts and identify all documents on which CIS relies to show  
16 that it satisfied the requirements of 35 U.S.C. Sec. 287(a) and is entitled to damages  
17 on allegedly infringing sales before this case was filed.

18 **Response:** CIS objects to this Interrogatory on the grounds that it incorrectly  
19 presumes CIS had, or currently has, any obligation to satisfy the requirements of 35  
20 U.S.C. § 287(a). By its terms, 35 U.S.C. § 287(a) applies only to "[p]atentees, and  
21 persons making, offering for sale, or selling within the United States any patented  
22 article for or under them, or importing any patented article into the United  
23 States." Based upon all the information presently available and known to CIS,  
24 neither CIS, nor any licensee of CIS, made, sold, or offered for sale within the  
25 United States any article patented under the Patents-in-Suit, or imported any such  
26 patented article into the United States. Furthermore, since at least 1998, neither  
27 CIS, nor any licensee of CIS, has made, sold, or offered for sale, within the United  
28 States or anywhere in the world any article patented under the Patents-In-Suit. The

1 “allegedly infringing sales” referenced in this Interrogatory relate to sales of  
2 Nintendo DS game cartridges containing certain Macronix-labeled Mask ROM  
3 chips and Nintendo Wii consoles containing certain Macronix-labeled Mask ROM  
4 chips, as identified in CIS’s Second Amended Complaint. The Nintendo DS game  
5 cartridges were first sold in the United States in 2004 and the Nintendo Wii console  
6 was first sold in the United States in 2006. Therefore, 35 U.S.C. § 287(a) did not  
7 apply to CIS during the period of time in which Defendants began infringing the  
8 Patents-In-Suit based upon the accused Nintendo DS game cartridges containing  
9 certain Macronix-labeled Mask ROM chips and Nintendo Wii consoles containing  
10 certain Macronix-labeled Mask ROM chips, as identified in CIS’s Second Amended  
11 Complaint, for example, paragraphs 21-22.

12

13       **Interrogatory No. 3.**    State in detail all facts and identify all documents on  
14 which CIS relies as an explanation for the delay in filing this case, for purposes of  
15 avoiding laches.

16

17       **Response:** CIS objects to this Interrogatory on the grounds that it lacks  
18 foundation because it incorrectly presumes CIS delayed filing this case. CIS also  
19 objects to this Interrogatory on the grounds that it improperly seeks to transfer the  
20 burden of proof for Defendants’ affirmative defense of laches to CIS. Subject to  
21 and without waiving its objections, CIS states that CIS has no burden to “avoid[]  
22 laches” or provide “an explanation for the delay” because there was no delay and  
23 there is no presumption of laches. CIS did not have knowledge of Defendants’  
24 infringements of the Patents-In-Suit based on the Macronix-labeled Mask ROM  
25 chips used in Nintendo DS game cartridges and Nintendo Wii consoles until 2009,  
as alleged in Plaintiff’s Second Amended Complaint.

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**Interrogatory No. 4.**

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State whether the ROM chips incorporating the inventions of the ‘497 and

1 '461 patents (or their packaging) that were made by Ricoh and sold to Nintendo  
2 Japan for use in Nintendo Japan's products for importation, use, and/or sale in the  
3 United States, as alleged in paragraph 13 of the SAC, were marked with the number  
4 of the '497 or the '461 patents. If the answer is "yes", state which patent number  
5 was marked, which company or individual caused them to be marked, and identify  
6 all facts, documents, and things that support the answer and any individuals who  
7 have knowledge of the marking.

8 **Response:** CIS objects to this Interrogatory on the grounds that the reference  
9 to "marking" is vague and ambiguous. The only requirement to "mark" patented  
10 articles is statutory-based, *see* 35 U.S.C. § 287(a). To the extent this Interrogatory's  
11 reference to "marking" is based upon 35 U.S.C. § 287(a), CIS objects to this  
12 Interrogatory on the grounds that it incorrectly presumes CIS or its licensee had, or  
13 currently has, any obligation under 35 U.S.C. § 287(a). Subject to and without  
14 waiving its objections, CIS states that based upon all the information presently  
15 available and known to CIS, neither CIS nor Ricoh made, sold, or offered for sale  
16 within the United States any article patented under the Patents-in-Suit, or imported  
17 any such patented article into the United States. Furthermore, since at least 1998,  
18 neither CIS nor Ricoh has made, sold, or offered for sale, within the United States or  
19 anywhere in the world any article patented under the Patents-In-Suit. CIS further  
20 states that it presently has no knowledge that any Mask ROM Chips covered by the  
21 '497 Patent and made by Ricoh and sold to Nintendo Japan were actually used in  
22 any Nintendo game product or, even if used in a Nintendo game product, were sold  
23 or offered for sale within the United States. Moreover, any such sales of Ricoh  
24 Mask ROM chips to Nintendo Japan or any other entity ceased in 1997 or early  
25 1998, prior to the issuance of the '461 Patent.

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27

**Interrogatory No. 5.**

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Describe in detail all activities undertaken by CIS, or by any party acting on

1 behalf of CIS, to investigate whether any of the defendants' products infringe the  
2 Patents-In-Suit, including a description of the activities, the product investigated, the  
3 date and location where they were performed, the parties conducting such activities,  
4 and the results.

5       **Response:** CIS objects to this Interrogatory on the grounds that it seeks  
6 information protected from disclosure or discovery by the attorney-client privilege  
7 and/or work product doctrine. Subject to and without waiving its objections, CIS  
8 provides the following non-privileged, non-work product information: On October  
9 9, 2008, CIS signed an agreement with Pachira IP. Pursuant to that agreement, and  
10 beginning in October 2008, Pachira investigated possible infringement of CIS  
11 patents, including by Macronix (MXIC or MXA) and/or Nintendo (NCL or NCA) in  
12 anticipation of litigation against Macronix and/or Nintendo. Pursuant to that  
13 agreement, CIS understood that Pachira would retain Chipworks (a Canadian  
14 company) as a consultant to undertake technical analysis or reverse engineering of  
15 potentially infringing products in order to determine infringement in anticipation of  
16 litigation. Subsequently, in January 2009, a Macronix-labeled ROM device, part  
17 number MX23L4005-24C1MAC, was obtained from a Nintendo Wii game console  
18 and reverse engineered to determine infringement in anticipation of litigation against  
19 Macronix and Nintendo. In May 2009, a Macronix-labeled ROM device, part  
20 number MX23L51208-15D2, was obtained from a Nintendo DS game cartridge and  
21 reverse engineered to determine infringement in anticipation of litigation against  
22 Macronix and Nintendo. This reverse engineering work product described above  
23 was performed by Chipworks and Pachira, on behalf of CIS, to determine  
24 infringement in anticipation of litigation. This work was performed in Ottawa,  
25 Canada. The content and substance of the reverse engineering work performed for  
26 CIS is protected from discovery as work product performed on behalf of CIS in  
27 anticipation of litigation.

28

1        **Interrogatory No. 6.**

2        Does CIS contend that the products accused of infringement in this case are  
3 different, for purposes of infringement of the Patents-In-Suit, from the “design  
4 layout as depicted in the Macronix ‘389 Patent”, as referred to in par. 16 of the  
5 SAC? If so, identify for which accused product(s) this is contended by CIS, and  
6 specifically describe the differences.

7        **Response:** CIS objects to this Interrogatory on the grounds that it seeks  
8 information protected from disclosure or discovery by the attorney-client privilege  
9 and/or work product doctrine. Subject to and without waiving its objections, CIS  
10 states that the design layout depicted in the Macronix, or MXIC, ‘389 Patent is  
11 different from the products accused of infringement in this case – *i.e.*, the Mask  
12 ROM Chips identified in the Second Amended Complaint and incorporated into the  
13 Nintendo game cartridges and Nintendo Wii console. For example, CIS understood  
14 from its review of the Macronix ‘389 Patent in 1994 that Figures 4 and 8 of that  
15 patent depicted two different design layouts. The design layout of contacts between  
16 the metal and diffusion layers of the embodiments of the Macronix ‘389 patent  
17 differs from the design layout of contacts for the ROM cell arrays in the accused  
18 products.

19

20        **Interrogatory No. 7.**

21        Describe in detail all the facts and circumstances that prompted CIS to  
22 investigate whether any current products of defendants infringe the Patents-In-Suit.

23        **Response:** CIS objects to this Interrogatory on the grounds that it seeks  
24 information protected from disclosure or discovery by the attorney-client privilege  
25 and/or work product doctrine. Subject to and without waiving its objections, CIS  
26 states Pachira IP approached CIS in 2008 with a proposal that Pachira IP investigate  
27 products to determine if there was infringement of any CIS patents. After Pachira  
28 IP and CIS signed the October 9, 2008 agreement, an investigation was begun of

1 products, including the accused products, in anticipation of litigation for  
2 infringement of the Patents-In-Suit.

3

4 **Interrogatory No. 8**

5 During the period 1996-2008, did CIS take any steps to investigate whether  
6 any products of any of the defendants infringed the Patents-In-Suit? If so, describe  
7 in detail what steps were taken, state when they were taken, who took them, and  
8 identify any documents relating to such steps.

9 **Response:** CIS objects to this Interrogatory on the grounds that it seeks  
10 information protected from disclosure or discovery by the attorney-client privilege  
11 and/or work product doctrine. CIS also objects to this Interrogatory to the extent  
12 that it presumes that CIS had an obligation to investigate whether any products of  
13 any of the defendants infringed the Patents-In-Suit. Subject to and without waiving  
14 these objections or the General Objections, during the period from 1996-2008, CIS  
15 had no information that would suggest that the accused products identified in its  
16 Second Amended Complaint infringed the Patents-In-Suit. Moreover, upon  
17 information and belief, none of the accused products was made, used, offered for  
18 sale, or sold in, or imported into, the United States until 2004, and therefore there  
19 could be no reason to take any steps to investigate the accused products until 2004 at  
20 earliest. CIS also had no information that would suggest that Defendants'  
21 representations in 1994 that their use of Mask ROM chip designs based upon the  
22 designs depicted in the MXIC '389 Patent were false or that Defendants had changed  
23 or modified their Mask ROM chip design in any relevant respect. For these reasons,  
24 and others, CIS did not have cause to investigate whether any products of any of the  
25 defendants infringed the Patents-In-Suit during the period 1996-2008.

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1 Dated: November 4, 2010

Respectfully submitted:

2 **BARNES AND THORNBURG LLP**

3 C. JOHN BROWN

4 By:

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Attorneys for Plaintiff Creative Integrated  
7 Systems, Inc.  
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VERIFICATION

I declare under the penalty of perjury that I am an authorized agent of Creative Integrated Systems, Inc. for purposes of executing as to the facts contained in the foregoing interrogatories; that some of the matters stated in the foregoing interrogatories are not within my personal knowledge; that the facts stated in the foregoing interrogatories have been assembled by employees and/or authorized agents of Creative Integrated Systems, Inc.; and that I am informed by those employees and/or authorized agents and believe that the facts stated in the foregoing interrogatories are true. I express no opinion regarding any legal issues set forth in such interrogatories or responses, and/or regarding the application of law to fact.

Dated: November 1, 2010

CREATIVE INTEGRATED  
SYSTEMS, INC.

By: James A. Komarek

Printed: James A. Komarek

Title: President

1 Dated: November 3, 2010

Respectfully submitted:

2 **BARNES AND THORNBURG LLP**

3 C. JOHN BROWN

4 By:

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6 Attorneys for Plaintiff Creative Integrated  
7 Systems, Inc.  
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## CERTIFICATE OF SERVICE

I hereby certify that on this 3rd day of November, 2010, a copy of the foregoing document was served by electronic mail and United States Mail, first-class postage prepaid, on the following counsel of record:

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